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PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			FOX, BRYAN J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: ~~2686~~-2617

DETAILED ACTION

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Pawlish et al (US005276916A).

Regarding **claim 1**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed, “foldable mobile phone in which a first case having a transmission microphone and a second case having a receiver are coupled to each other so as to be opened and closed freely,” and, “a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed.” The system includes volume up and down controls, which reads on the claimed, “volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver.” A position switch comprising sensing means to determine the relative position of the housing portions 11 and 12 and coupled to the controller in order to

provide automatic control features in the radio 10 relating to the positions of the housing portions. When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, “switching unit which switches setting functions so that a first function for communicating by using the transmission microphone and the receiver is set in a case of communicating at a state that the first case and the second case are opened to each other, and a second function for communicating by using the transmission microphone and the speaker is set such that the sounding volume of the receiver by the volume variable unit in a case of communicating at a state that the first case and the second case are closed to each other.”

Regarding **claim 4**, Pawlish et al disclose the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see column 2, line 65 – column 3, line 42), which reads on the claimed, “the switching unit switches to the first function when the first case and the second case are opened to each other in a state that the second function is set.”

Regarding **claim 5**, Pawlish et al disclose the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the

housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see column 2, line 65 – column 3, line 42), which reads on the claimed, “the switching unit switches to the second function when the first case and the second case are closed to each other in a state that the first function is set.”

Regarding **claim 9**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed, “foldable mobile phone in which a first case having a transmission microphone and a second case having a receiver are coupled to each other so as to be opened and closed freely,” and, “a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed.” The system includes volume up and down controls. A position switch comprising sensing means to determine the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features in the radio 10 relating to the positions of the housing portions. When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, “switching unit, which switches the speaker so that the speaker is available as a receiver at a time of communication; and an adjusting unit, which adjusts a sounding volume of the speaker to a lower level than a sounding

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volume at a time of an incoming call in a state of available to use the speaker as the receiver."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlish in view of Imai (US006389267B1).

Regarding **claim 2**, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed, "foldable mobile phone in which a first case having a transmission microphone and a second case having a receiver are coupled to each other so as to be opened and closed freely," and,

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“a speaker, which is provided at a portion of the second case which is exposed when the first case and the second case are closed.” The system includes volume up and down controls, which reads on the claimed, “volume variable unit which adjusts a sounding volume of the speaker to a level substantially same as a sounding volume of the receiver.” When the radio is in the open position, the volume of the speaker port is set to a different level than in the open position (see column 2, line 65 – column 3, lines 42), which reads on the claimed, “switching unit which switches setting functions so that a first function for communicating by using the transmission microphone and the receiver is set in a case of communicating at a state that the first case and the second case are opened to each other, and a second function for communicating by using the transmission microphone and the speaker is set such that the sounding volume of the receiver by the volume variable unit in a case of communicating at a state that the first case and the second case are closed to each other.” Pawlish et al fail to expressly disclose a first button which has a function of a first communication starting operation unit and a second button having a function of a second communication starting operation unit.

In a similar field of endeavor, Imai discloses a system where when a call arrives and the second key operation section 8 is operated, the first speech transmitting and receiving unit is set to be inactive and the second speech transmitting and receiving unit is set to an active state. On the other hand, when the first key operation section 5 is operated without operation of the second key operation section 8 in the step S103, the speech communication is started in the states just as it is (see column 6, lines 16-26),

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which reads on the claimed, "first button, which has a function of a first communication starting operation unit, and provided at a portion which is not exposed when the first case and the second case are closed but exposed in a opened state of the first case and the second case; a second button having a function of a second communication starting operation unit and provided at a portion which is exposed when the first case and the second case are closed."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pawlish et al with Imai to include the above buttons for choosing the communication section in order to allow the user to choose the communication state.

Regarding **claim 3**, Pawlish et al disclose a microphone port 24 exposed when the case is closed (see column 2, lines 40-44 and figure 2), which reads on the claimed, "the transmission microphone is provided at a portion of the first case which is away from a coupling portion of the first and second cases and exposed when the first case and the second case are closed." Pawlish et al fails to disclose a receiver covered by the first case when the first case and second case are closed.

In a similar field of endeavor, Imai discloses a system with a receiver that is covered when closed (see figures 2a and 2b), which reads on the claimed, "the receiver is provided at a portion of the second case which is away from the coupling portion and covered by the first case when the first case and the second case are closed."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Pawlish et al with Imai to include the above receiver that is covered by the case when closed in order to protect the receiver and provide a more balanced device.

Regarding **claim 4**, the combination of Pawlish et al and Imai discloses the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see Pawlish et al column 2, line 65 – column 3, line 42), which reads on the claimed, "the switching unit switches to the first function when the first case and the second case are opened to each other in a state that the second function is set."

Regarding **claim 5**, the combination of Pawlish et al and Imai discloses the use of a position switch used for determining the relative position of the housing portions 11 and 12 and coupled to the controller in order to provide automatic control features relating to the positions of the housing portions 11 and 12. When the radio is in the open position, a different configuration is used than when the phone is in a closed positions (see Pawlish et al column 2, line 65 – column 3, line 42), which reads on the claimed, "the switching unit switches to the second function when the first case and the second case are closed to each other in a state that the first function is set."

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlish in view of Imai as applied to claim 2 above, and further in view of Ishinabe et al (US005600655A).

Regarding **claim 6**, the combination of Pawlish and Imai fails to expressly disclose the second button has a function of a first communication terminating operation unit for terminating the communication when the second button is operated during communication.

In a similar field of endeavor, Ishinabe et al disclose a communication key used for start/end of communication (see column 2, lines 57-67 and figure 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Pawlish and Imai with Ishinabe et al to include the above key that starts and ends communication in order to save space in the keypad.

Regarding **claim 7**, as applied to claim 6, the above combination of Pawlish, Imai and Ishinabe et al discloses continuously operating the second button for a predetermined time period, wherein if the button is pressed at all the operation would read on the continuously operating for a predetermined time period wherein the time period is small.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlish in view of Imai as applied to claim 2 above, and further in view of what was well known in the art (see MPEP 2144.03).

Regarding **claim 8**, the combination of Pawlish and Imai suggests a recessed button 14 at an outer face (see figure 1). The combination of Pawlish and Imai fails to expressly disclose the second button is disposed within a recess portion formed at an outer face of at least one of the first case and second case.

The examiner takes official notice that a button disposed within a recess portion formed at an outer face of at least one of the first case and second case was well known to a person of ordinary skill in the art at the time of the invention.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Pawlish and Imai such that the second button is disposed within a recess portion formed at an outer face of at least one of the first case and second case in order to lessen the likelihood of accidentally operating the button.

Response to Arguments

Applicant's arguments filed December 22, 2005 have been fully considered but they are not persuasive.

The Applicant argues that Pawlish does not disclose a foldable mobile phone comprising a first case having a transmission microphone and a second case having a receiver and a speaker, which is exposed when the first case and the second case are closed. The Examiner respectfully disagrees. As recited in the rejection above, Pawlish et al disclose a communication device that includes a first housing portion 11 and a second housing portion 12 hinged together with a speaker in the first housing portion

and a microphone on the second housing portion (see column 2, lines 28-44 and figure 1), which reads on the claimed language.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the receiver in the present application is another speaker) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant makes similar arguments with respect tot the remaining claims, however, for the same reasons outlined above, the Examiner respectfully disagrees.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bryan Fox
March 29, 2006


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER